

### **REMARKS**

Claim 1 has been amended to incorporate the subject matter of claim 11. Accordingly, claim 11 has been cancelled. Claim 12 has been amended to change its dependency from claim 11 to claim 1.

Claims 1; 4; 12; and 23 remain in the application. Of these, claim 1 is the sole independent method claim.

Reexamination and reconsideration are respectfully requested in view of the amendments and the following remarks.

The claims stand rejected under 35 U.S.C. § 103 (a) based upon a Witherow (US 4,217,903). The Examiner refers to an “introductory statement of intended use” and “other functional statements” and states that they “do not impose any structural limitations on the claims.” The Examiner also states that “Witherow would be inherently capable of utilizing in cancellous bone as well as performing the steps of the method claim.”

Claim 1 is a method claim that defines the manipulation of a tool with a platform and an expandable structure in cancellous bone to form a cavity by compressing cancellous bone in one region while another region of the cancellous bone remains substantially not compressed. Claim 1, as amended, also defines the introduction of a filling material into the cavity. Claim 1 is not directed to an “intended use” and does not include “functional statements,” but rather functional steps that properly define the manipulation of the tool and expandable structure in bone.

The method defined in amended claim 1 is nowhere taught or suggested by Witherow. Witherow’s sole objective is to drain urine from a bladder. There is nothing in Witherow that would fairly lead to a conclusion that Witherow would be “inherently capable” of preferentially forming a cavity in cancellous bone. Witherow’s balloon expands within the bladder for an entirely different purpose: to separate the insertion end of a catheter into two branches so that urine can be drained from a bladder. The “inherently capable” conclusion unfairly transforms Witherow’s balloon for use for an entirely different purpose and in an entirely different anatomical structure. The “inherently capable” conclusion arises purely from hindsight, with prior knowledge and appreciation of applicant’s invention. Furthermore, there is nothing in Witherow that teaches or suggests the introduction of a filling material, as defined in amended claim 1. Witherow’s entire objective is to get material out of the bladder, not to put filling material into the bladder. There is nothing in

Witherow that is “inherently capable” of performing a filling function, and, in fact, everything in Witherow teaches away from such a function.

Applicant therefore believes claims 1; 4; 12; and 23 are in condition for allowance.

Respectfully Submitted,

By

  
Daniel D. Ryan

Registration No. 29,243

RYAN KROMHOLZ & MANION, S.C.  
Post Office Box 26618  
Milwaukee, Wisconsin 53226  
(262) 783 - 1300  
Customer No.: 26308